

### ***REMARKS***

The Examiner is thanked for the thorough examination of the present application. The Office Action mailed November 3, 2006 rejected claims 1, 2, 4-21, and 23-28. This is a full and timely response to that outstanding Office Action. Upon entry of the amendments in this response, claims 1, 2, 4-21, and 23-28 are pending. More specifically, claims 1, 8, 9, 18, 21, and 26 are amended. Claims 1, 2, 4-21, and 23-28 are pending. These amendments are specifically described hereinafter.

#### **I. Present Status of Patent Application**

Claims 1, 2, 4-7, 21, and 23-25 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by *Progrebisky, et al.* (U.S. Patent No. 5,958,008). Claims 8-20, and 26-28 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Progrebisky, et al.* (U.S. Patent No. 5,958,008) in view of *Gross, et al.* (U.S. Patent No. 6,782,510). These rejections are respectfully traversed.

#### **II. Examiner Interview**

Applicant first wishes to express sincere appreciation for the time that Examiner Vu spent with Applicant's representative Benjie Balser during a February 5, 2007 telephone discussion regarding the above-identified Office Action. During the interview, various features described in the patent application and recited in the independent claims, including detecting when there is at least one but no more than a maximum

number of discrepancies between a domain name in the domain name database and the extracted domain name, and *Progrebisky* were discussed, and that the outcome of this discussion is addressed herein. During that conversation, Examiner Vu seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Vu carefully consider this amendment and response.

### III. Rejections Under 35 U.S.C. §102(b)

#### A. Claims 1, 2, and 4-7

The Office Action rejects claims 1, 2, and 4-7 under 35 U.S.C. 102(b) as allegedly being anticipated by *Progrebisky, et al.* (U.S. Patent No. 5,958,008). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 1**, as amended. recites:

1. A method of providing a system for automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
  - creating an incoming domain name list in a memory;
  - receiving an incoming email communication;
  - extracting a domain name from a sender's email address from the incoming email communication;
  - storing the domain name in the incoming domain name list in the memory;
  - checking if a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication is included in the incoming domain name list in the memory;
  - checking if a discrepancy exists between a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication and a domain name included in the incoming domain name list in the memory by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name;** and

transmitting the outgoing email communication if the domain name is included in the incoming domain name list, otherwise generating a prompt for a user to confirm an e-mail address associated with the intended recipient of the outgoing e-mail communication.

(Emphasis added).

Applicant respectfully submits that claim 1 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1, as amended, is allowable for at least the reason that *Progrebisky* does not disclose, teach, or suggest at least **checking if a discrepancy exists between a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication and a domain name included in the incoming domain name list in the memory by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name**. Even if, *arguendo*, *Progrebisky* discloses filtering URLs found in a web page, *Progrebisky* fails to disclose checking if a discrepancy exists between a domain name of an e-mail address associated with an intended recipient of an outgoing e-mail communication and a domain name included in the incoming domain name list in the memory by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name. Therefore, *Progrebisky* does not anticipate independent claim 1, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 1, as amended, is allowable over the cited references of record, dependent claims 2 and 4-7 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2 and 4-7 contain all the features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2 and 4-7 are patentable over *Progrebisky*, the rejection to claims 2 and 4-7 should be withdrawn and the claims allowed.

B. Claims 21 and 23-25

The Office Action rejects claims 21 and 23-25 under 35 U.S.C. 102(b) as allegedly being anticipated by *Progrebisky, et al.* (U.S. Patent No. 5,958,008). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 21**, as amended. recites:

21. A method of automatically checking for an incorrect e-mail address in an outgoing e-mail communication, comprising:
- creating an incoming email address list in a memory;
  - receiving an incoming email communication;
  - storing, in the incoming email address list in the memory, an email address extracted from the incoming email communication;
  - checking if an e-mail address associated with an intended recipient of the outgoing e-mail communication is included in the incoming email address list in the memory;
- checking if a discrepancy exists between an e-mail address associated with an intended recipient of the outgoing e-mail***

***communication and an email address included in the incoming email address list in the memory by detecting when there is at least one but no more than a maximum number of discrepancies between an email address in the email address list and the e-mail address associated with an intended recipient of the outgoing e-mail communication;*** and transmitting the outgoing email communication if the e-mail address is included in the incoming email address list, otherwise generating a prompt for a user to confirm an e-mail address if the email address is not included in the incoming email address list.

(Emphasis added).

Applicant respectfully submits that claim 21 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 21, as amended, is allowable for at least the reason that *Progrebisky* does not disclose, teach, or suggest at least **checking if a discrepancy exists between an e-mail address associated with an intended recipient of the outgoing e-mail communication and an email address included in the incoming email address list in the memory by detecting when there is at least one but no more than a maximum number of discrepancies between an email address in the email address list and the e-mail address associated with an intended recipient of the outgoing e-mail communication.** Even if, *arguendo*, *Progrebisky* discloses filtering URLs found in a web page, *Progrebisky* fails to disclose checking if a discrepancy exists between an e-mail address associated with an intended recipient of the outgoing e-mail communication and an email address included in the incoming email address list in the memory by detecting when there is at least one

but no more than a maximum number of discrepancies between an email address in the email address list and the e-mail address associated with an intended recipient of the outgoing e-mail communication. Therefore, *Progrebisky* does not anticipate independent claim 21, and the rejection should be withdrawn for at least that reason.

For at least the reason that independent claim 21, as amended, is allowable over the cited references of record, dependent claims 23-25 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 23-25 contain all the features of independent claim 21. Therefore, since dependent claims 23-25 are patentable over *Progrebisky*, the rejection to claims 23-25 should be withdrawn and the claims allowed.

#### **IV. Rejections Under 35 U.S.C. §103(a)**

##### **A. Claims 8-17**

The Office Action rejects claims 8-17 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Progrebisky, et al.* (U.S. Patent No. 5,958,008) in view of *Gross, et al.* (U.S. Patent No. 6,782,510). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 8**, as amended. recites:

8. A method of automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:
  - receiving email communications incoming to the email communications server;
  - creating a domain name database;

extracting domain names in sender's e-mail addresses from the e-mail communications incoming to the email communications server;  
storing extracted domain names in the domain name database;  
receiving outgoing e-mail communications from client computers connected to the e-mail communications server through a local network;  
***searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name;*** and  
generating an error prompt upon detecting that a domain name in an e-mail address provided in an outgoing e-mail communication is misspelled.

(Emphasis added).

Applicant respectfully submits that claim 8 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 8 is allowable for at least the reason that the combination of *Progrebisky* and *Gross* does not disclose, teach, or suggest at least ***searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name.*** Even if, *arguendo*, *Progrebisky* discloses filtering URLs found in a web page, *Progrebisky* fails to disclose searching the domain name database for domain names spelled similarly to the domain names in e-mail

addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name.

Gross discloses a word processing tool for checking the substance and not merely the spelling of words by identifying potentially inappropriate word choices so that unintentional errors are not introduced into electronic text documents. Gross fails to disclose searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of the outgoing e-mail communication provided in the outgoing e-mail communications; by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 8, the rejection should be withdrawn for at least that reason. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 8 is allowable.

For at least the reason that independent claim 8 is allowable over the cited references of record, dependent claims 9-17 (which depend from independent claim 8) are allowable as a matter of law for at least the reason that dependent claims 9-17 contain all the features of independent claim 8. Therefore, the rejection to claims 9-17 should be withdrawn and the claims allowed.



B. Claims 18-20

The Office Action rejects claims 18-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Progrebisky, et al.* (U.S. Patent No. 5,958,008) in view of *Gross, et al.* (U.S. Patent No. 6,782,510). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 18**, as amended. recites:

18. An e-mail server for automatically checking for misspelled e-mail addresses in outgoing e-mail communications prior to transmission by an e-mail communications server, comprising:

- an interceptor for extracting domain names from e-mail addresses provided in incoming and outgoing e-mail communications;
- a database generator for generating a domain name database for storing domain names extracted from sender's e-mail addresses in incoming e-mail communications; and
- a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name,***

wherein the e-mail server prompts the user when it detects misspelled domain names in e-mail addresses in outgoing e-mail communications.

(Emphasis added).

Applicant respectfully submits that claim 18 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. §103, the cited combination of references must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 18 is allowable for at least the reason that the combination of *Progrebisky* and *Gross* does not disclose, teach, or

**suggest at least a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name.** Even if, *arguendo*, *Progrebisky* discloses filtering URLs found in a web page, *Progrebisky* fails to disclose a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name.

Gross discloses a word processing tool for checking the substance and not merely the spelling of words by identifying potentially inappropriate word choices so that unintentional errors are not introduced into electronic text documents. Gross fails to disclose a checker for searching the domain name database for domain names spelled similarly to the domain names in e-mail addresses associated with intended recipients of in the outgoing e-mail communications by detecting when there is at least one but no more than a maximum number of discrepancies between a domain name in the domain name database and the extracted domain name.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 18, the rejection should be withdrawn for at least that reason. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 18 is allowable.

For at least the reason that independent claim 18 is allowable over the cited references of record, dependent claims 19 and 20 (which depend from independent claim 18) are allowable as a matter of law for at least the reason that dependent claims 19 and 20 contain all the features of independent claim 18. Therefore, the rejection to claims 19 and 20 should be withdrawn and the claims allowed.

C. Claims 26-28

The Office Action rejects claims 26-28 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Progrebisky, et al.* (U.S. Patent No. 5,958,008) in view of *Gross, et al.* (U.S. Patent No. 6,782,510). For at least the reasons set forth below, Applicant respectfully traverses the rejection.

**Independent claim 26**, as amended, recites:

26. An e-mail communications system stored in a client computer for automatically checking for incorrect e-mail addresses provided in outgoing e-mail communications from the client computer prior to transmission to an e-mail server, comprising:

- an address extractor for extracting sender's e-mail addresses from incoming e-mail communications;
- a previous sender addresses memory for storing e-mail addresses extracted from sender's e-mail addresses in incoming e-mail communications;
- a checker for searching the previous sender addresses memory for e-mail addresses of intended recipients that are provided in outgoing e-mail communications, and

***a checker for searching for a discrepancy between a sender address and the previous sender addresses memory for e-mail addresses of intended recipients that are provided in outgoing e-mail communications by detecting when there is at least one but no more than a maximum number of discrepancies between a previous sender address in the***

***previous sender address memory and the email address of an intended recipient,***

wherein the checker generates a prompt for verification of an e-mail address of an intended recipient upon detecting that an e-mail address of an intended recipient in an outgoing e-mail communication is not present in the previous sender addresses memory.

(Emphasis added).

Applicant respectfully submits that claim 26 patently defines over the cited art for at least the reason that the cited art does not disclose the features emphasized above. For a proper rejection of a claim under 35 U.S.C. § 103, the cited combination of references must disclose, teach, or suggest all elements/features of the claim at issue.

Applicant respectfully submits that independent claim 26 is allowable for at least the reason that the combination of *Progrebisky* and *Gross* does not disclose, teach, or suggest at least **a checker for searching for a discrepancy between a sender address and the previous sender addresses memory for e-mail addresses of intended recipients that are provided in outgoing e-mail communications by detecting when there is at least one but no more than a maximum number of discrepancies between a previous sender address in the previous sender address memory and the email address of an intended recipient.** Even if, *arguendo*, *Progrebisky* discloses filtering URLs found in a web page, *Progrebisky* fails to disclose a checker for searching for a discrepancy between a sender address and the previous sender addresses memory for e-mail addresses of intended recipients that are provided in outgoing e-mail communications by detecting when there is at least one but no more than a maximum number of discrepancies between a

previous sender address in the previous sender address memory and the email address of an intended recipient.

Gross discloses a word processing tool for checking the substance and not merely the spelling of words by identifying potentially inappropriate word choices so that unintentional errors are not introduced into electronic text documents. Gross fails to disclose a checker for searching for a discrepancy between a sender address and the previous sender addresses memory for e-mail addresses of intended recipients that are provided in outgoing e-mail communications by detecting when there is at least one but no more than a maximum number of discrepancies between a previous sender address in the previous sender address memory and the email address of an intended recipient.

As the cited combination of references does not disclose, teach, or suggest, either implicitly or explicitly, all the elements of claim 26, the rejection should be withdrawn for at least that reason. Additionally and notwithstanding the analysis hereinabove, there are other reasons why claim 26 is allowable.

For at least the reason that independent claim 26 is allowable over the cited references of record, dependent claims 27 and 28 (which depend from independent claim 26) are allowable as a matter of law for at least the reason that dependent claims 27 and 28 contain all the features of independent claim 26. Therefore, the rejection to claims 27 and 28 should be withdrawn and the claims allowed.

**V. Miscellaneous Issues**

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1, 2, 4-21, and 23-28 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

It is believed that no extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 20-0778.

Respectfully submitted,

/BAB/

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